



P/1318-73

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Robert Barritz, et al.

Serial No.: 09/518,048

Filed: March 2, 2000

For: METHOD AND PROCESS FOR DISPLAYING SOFTWARE PRODUCT
INVENTORY AND USAGE INFORMATION CORRELATED WITH LICENSE
AGREEMENT INFORMATION

Confirmation No.: 5346

Date: September 6, 2007

Group Art Unit: 2134

Examiner: Matthew E. Heneghan

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. §41.37

Sir:

This appeal is taken from the Final Office Action mailed March 6, 2007. In support of the Notice of Appeal filed June 6, 2007, the following Appeal Brief is presented.

I. REAL PARTY IN INTEREST:

The real party in interest in the above-identified application is: International Business Machines Corporation.

II. RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences of which applicants are aware regarding the above-identified application.

09/11/2007 CNEGAI 00000006 09518048
01 FC:1402 500.00 OP

III. STATUS OF CLAIMS:

Claims 34-43 and 46-51 are pending. Claims 34-43 and 46-51 are rejected and are involved in the instant appeal.

Claims 1, 14, 34 and 57 were amended in an Amendment dated May 3, 2004 in response to a non-final Office Action dated March 8, 2004.

Claims 1, 14 and 34 were amended in an Amendment dated August 10, 2004 in response to a final Office Action dated June 3, 2004.

Claims 1-14, 34, 49, 50 and 51, were amended in an Amendment dated June 1, 2005 in response to a non-final Office Action dated March 1, 2005.

An Amendment was filed November 17, 2005 in response to an Office Action dated August 17, 2005. No amendments to the claims were made.

A Notice of Appeal was filed on January 17, 2006 in response to an Advisory Action dated December 28, 2005.

A Request for Continued Examination was filed with an Amendment dated April 17, 2006. Claims 1-33 and 44-45 and 52-57 were canceled. Claims 34 and 49-51 were amended.

An Amendment was filed January 17, 2007 in response to an Office Action dated July 17, 2006.

A Notice of Appeal was filed on June 6, 2007 in response to a final Office Action dated March 6, 2007.

Claims 34, 35, 41-47 and 48 stand rejected under 35 U.S.C. §102(e) as being anticipated by Franklin et al. ("Franklin," U.S. Patent No. 6,105,069).

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin.

Claims 46, 47, 50 and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Mangat et al. ("Mangat," U.S. Patent No. 6,049,799).

Claims 42 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Todd et al. ("Todd," U.S. Patent No. 5,867,714).

Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Elmasri et al. ("Elmasri," "Fundamentals of Database Design," 1989, pp. 544-545).

IV. STATUS OF AMENDMENTS:

An Amendment in response to a non-final Office Action dated March 8, 2004 was filed on May 3, 2004. An Amendment in response to a final Office Action dated June 3, 2004 was filed on August 10, 2004. An Amendment in response to non-final Office Action dated March 1, 2005 was filed on June 1, 2005. An Amendment in response to a non-final Office Action dated August 17, 2005 was filed on November 17, 2005. A Notice of Appeal was filed on January 17, 2006 in response to an Advisory Action dated December 28, 2005. A Request for Continued Examination was filed with an Amendment dated April 17, 2006. An Amendment in response to an Office Action dated July 17, 2006 was filed on January 17, 2007. A Notice of Appeal was filed on June 6, 2007 in response to a final Office Action dated March 6, 2007. No amendment after the final Office Action dated March 6, 2007 was filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER:

Applicants' claim 34 is directed to a system for "correlating metrics" (page 7, lines 9-10) that are associated with "a plurality of software products" (page 11, lines 14-15) with "related software agreement data" (page 11, lines 16-17). Applicants' claim 34 system includes a first facility that is operable "to interface" with a product API of "at least one of the...products" to "obtain...related...agreement data" 22 (page 14, line 19-page 15, line 12, Figures 1, 3). Further, a second facility is operable "to interface" with the same product API to obtain ... related ... product data" (page 17, lines 20-24). A third facility correlates substantially automatically the product data and the agreement data with one another (page 33, line 25-page 34, Fig. 4). A fourth facility outputs the results of the correlation (page 24, lines 2-6). Furthermore, the system is not operable to affect operation of any software identified by data correlated by the third facility (page 10, lines 17-24).

Thus, applicants' claimed invention improves upon prior art license managers by having information pertaining to software products and agreement information correlated and output.

Dependent claim 35, which depends from applicants' claim 34, further defines the computer as a "mainframe computer" (see page 10, lines 25-28).

Dependent claim 36, which depends from applicants' claim 34, further defines the computer as a "network of computers" (see page 10, lines 25-28).

Dependent claim 37, which depends from applicants' claim 34, further defines the software product data as "inventory data" (see page 12, lines 6-8).

Dependent claim 38, which depends from applicants' claim 34, further defines the software product data as "usage data" (see page 12, lines 6-8).

Dependent claim 39, which depends from applicants' claim 34, further defines the software product data as a "combination of inventory data and usage data" (see page 12, lines 6-8).

Dependent claim 40, which depends from applicants' claim 34, further defines the agreement data as containing a "plurality of date fields" (see page 30, lines 11-18).

Dependent claim 41, which depends from applicants' claim 40, further defines the date fields are selected from a group including "time and date of transaction; name, address, phone number, e-mail address of vendor; description of asset; manufacturer, model, year, options; warranties, contract terms and conditions; contract information, fee structure; number of concurrent users; renewal dates; MIPS authorization; authorized CPUs; product name; and discounts" (see page 28, line 22-page 32, line 27).

Dependent claim 42, which depends from applicants' claim 34, further defines the first software facility to comprise a "data acquisition system including a plurality of software acquisition tools" (see page 11, lines 25-26).

Dependent claim 43, which depends from applicants' claim 42, further defines the software acquisition tools include an "importing tool for importing at least a portion of the software product data" (see page 12, lines 9-11).

Dependent claim 46, which depends from applicants' claim 34, further defines the third software facility comprises a "reconciliation and association facility which includes a plurality of software tools" (see page 10, lines 15-16).

Dependent claim 47, which depends from applicants' claim 46, further defines the reconciliation and association tools to include a tool for "resolving inconsistencies and mismatches in product names between the software product data and the software agreement data" (see page 16, lines 25-27).

Dependent claim 48, which depends from applicants' claim 34, further defines the third software facility is effective for "correlating at least 25% of the data contained in one of the software product data and the software agreement product data" (see page 14, lines 1-4).

Dependent claim 49, which depends from applicants' claim 34, further defines the at least one of the first computerized software facility and the second computerized software facility "interface with the at least one software product on a periodic basis" (see page 24, lines 15-17).

Dependent claim 50, which depends from applicants' claim 34, further defines the at least one of the first computerized software facility and the second computerized software facility "interface with the at least one software product on a continuous basis" (see page 25, lines 4-10).

Dependent claim 51, which depends from applicants' claim 34, further defines the at least one of the first computerized software facility and the second computerized software facility "interface with the at least one software product in response to alterations in an inventory of the software products" (see page 24, lines 21-26).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

The following grounds of rejection are presented for review:

A. Claims 34, 35, 41-47 and 48 stand rejected under 35 U.S.C. §102(e) as being anticipated by Franklin et al. ("Franklin," U.S. Patent No. 6,105,069).

B. Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin.

C. Claims 46, 47, 50 and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Mangat et al. ("Mangat," U.S. Patent No. 6,049,799).

D. Claims 42 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Todd et al. ("Todd," U.S. Patent No. 5,867,714).

E. Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Elmasri et al. ("Elmasri," "Fundamentals of Database Design," 1989, pp. 544-545).

ARGUMENT:

A. Argument Under 35 U.S.C. §102(e)

Claims 34, 35, 41-47 and 48 should not be rejected under 35 U.S.C. §102(e) as being anticipated by Franklin et al. (“Franklin,” U.S. Patent No. 6,105,069).

Franklin is directed to “centrally managing application programs in a computer network” (column 2, lines 16-21). Franklin teaches use of various objects, including group objects, user objects, resource objects and other application objects that store attributes, including license related information, that are used by the Network Application Launcher 190 when various applications are called (see, for example, Figs. 3-11). An application’s calling API (e.g., 252) may be operable to access license information from an application object 100, such as to “consume [an] attribute 110,” which may include licensing attributes 160 +(see column 9, lines 31-42). However, unlike applicants’ claim 34, an “executable file” (i.e., applicants’ claimed “software product”) does not include an API that is operable to provide software agreement information to an application object 100 (see column 4, line 66-column 5, line 1). Instead, Franklin teaches use of object 92 that is “associated” with an “actual executable file.”

Franklin does not teach or suggest a first facility operable to interface with an API of a software product (i.e., Franklin’s “actual executable file”) in order to obtain related agreement data and a second software facility operable to interface with that same API to obtain software product data. In other words and unlike Franklin, applicants’ claim 34 defines facilities that interface with a software product (via that product’s API) to obtain agreement data and software product data. Franklin, instead, discloses storing licensing information in attributes objects that Franklin’s Network Application Launcher associates with the “actual executable file,” and, further that Franklin’s system references those attributes via a respective API, for example, provided in the Network Application Launcher.

Applicants submit that the features and structure of applicants’ claim 34 system, including the way that applicants’ claim 34 system operates, is fundamentally different from Franklin. As part of Novell’s NetWare network, Franklin requires a licensing controller that includes objects of data obtained from various sources and stored for use by Novell’s known Network Application Launcher. The objects are formatted and stored in a complex arrangement of data structures, applications and dynamic link libraries, and are selectively accessible via application programming interfaces for use with Novell’s NetWare system. The various objects

defined in Franklin improve the way the Network Application Launcher works, including for load balancing, managing computer software applications, and for implementing software licenses during execution of software programs.

The Examiner states that Franklin “constitutes a knowledge based facility” and “organizes databases into objects, such as for users, resources and software licenses.” The Examiner further states “[t]he resources are organized into a database that constitutes an inventory list.” Further, the Examiner states that Franklin “includes a query tool for using the various database that outputs query results.” Applicants respectfully submit that these features cited by the Examiner do not teach or suggest applicants’ claim 34 system that includes a software product API that provides both software agreement data and software product data to first and second software facilities, respectively. Thus, elements of applicants’ claim 34 are missing from the teachings of Franklin.

Also, the Examiner cites to Franklin for disclosing “licensing objects [that] may be implemented as API’s” and a “procedure that retrieves licensing information from the resources” and a “process by which necessary additional functionalities may be spawned by the applications.” Applicants respectfully submit that Franklin’s licensing objects may be implemented as API’s, but, unlike applicants’ claim 34, that such API’s are not of the respective software product(s). Further, the additional functionalities “spawned” by the applications relate to Franklin’s licensing controller, and not the “actual executable files” (or applicant’s claimed “software products”). Applicants maintain that Franklin’s system is patentably distinct from applicants’ claim 34 that defines one or more software products that have an API providing software agreement data and software product data to first and second software facilities, respectively.

Moreover, the Examiner’s contends that Franklin discloses embodiments “wherein the product is used for database maintenance by an administrator rather than for the direct execution of a software product (see column 16, lines 12-23 and figures 11 and 12).” Applicants’ respectfully disagree. Franklin explicitly recites that “licensing attributes may be used by executables to control access by a user to properly licensed instances of a resource corresponding to the resource object” (see Abstract). Further, Franklin’s system provide “run control of applications” (see column 1, lines 12-16). Thus, Franklin does not teach a system that is “not

operable to affect operation of any software product identified by data correlated by [applicants'] third computerized software facility," as defined in applicants' claim 34.

Thus, Franklin does not teach or suggest applicants' claimed single "respective software product API" that provides both agreement data and software product data to two respective software facilities, nor does Franklin teach a system that is "not operable to affect operation of any software product. Therefore, and based on the foregoing, applicants respectfully submit that Franklin teaches a patentably distinct system and does not anticipate applicants' claim 34, under 35 U.S.C. §102(e).

Claims 35, 41-43 and 46-48 depend directly or indirectly from claim 34 and are, therefore, patentable for the same reasons as well as because of the combination of features set forth in those claims with the features set forth in the claim(s) from which they depend.

B. Argument Under 35 U.S.C. §103(a)

Claim 36 should not be rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin.

Claim 36 is rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin and the Examiner taking official notice that use of mainframes as servers is well know. Applicants respectfully submit that, for the same reasons as set forth above, claim 36 is patentable as well because of the combination of features in claim 36 with the features set forth in claim 34.

C. Argument Under 35 U.S.C. §103(a)

Claims 46, 47, 50 and 51 should not be rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Mangat et al. ("Mangat," U.S. Patent No. 6,049,799).

Claims 46, 47, 50 and 51 depend directly or indirectly from claim 34. Applicants respectfully submit that Mangat does not supply the elements of applicants' claim 34 that are missing from the teachings of Franklin. In particular, Mangat does not teach or suggest a first software facility that is operable to interface with an API of one or more software products in order to obtain related software agreement data, and a second software facility operable to interface with that same API to obtain software product data. Therefore, for the same reasons as set forth above, applicants respectfully submit that the combination of Mangat and Franklin do not teach or suggest all of the elements of applicants' claim 34. Therefore, claims 46, 47 and 50

which depend directly or indirectly from claim 34, are patentable for the same reasons as well, because of the combination of features in those claims with the features set forth in claim 34.

D. Argument Under 35 U.S.C. §103(a)

Claims 42 and 43 should not be rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Todd et al. (“Todd,” U.S. Patent No. 5,867,714).

Claims 42 and 43 depend directly or indirectly from claim 34. Applicants respectfully submit that Todd does not supply the elements of applicants’ claim 34 that are missing from the teachings of Franklin. In particular, Todd does not teach or suggest a first software facility that is operable to interface with an API of one or more software products in order to obtain related software agreement data, and a second software facility operable to interface with that same API to obtain software product data. Therefore, for the same reasons as set forth above, applicants respectfully submit that the combination of Todd and Franklin do not teach or suggest all of the elements of applicants’ claim 34. Therefore, claims 42 and 43 which depend directly or indirectly from claim 34, are patentable for the same reasons, as well as because of the combination of features in those claims with the features set forth in claim 34.

E. Argument Under 35 U.S.C. §103(a)

Claim 49 should not be rejected under 35 U.S.C. §103(a) as being unpatentable over Franklin as applied to claim 34 above, and further in view of Elmasri et al. (“Elmasri,” “Fundamentals of Database Design,” 1989, pp. 544-545).

Claim 49 depends directly or indirectly from claim 34. Applicants respectfully submit that Elmasri does not supply the elements of applicants’ claim 34 that are missing from the teachings of Franklin. In particular, Elmasri does not teach or suggest a first software facility that is operable to interface with an API of one or more software products in order to obtain a related software agreement data, and a second software facility operable to interface with that same API to obtain software product data. Therefore, for the same reasons as set forth above, applicants respectfully submit that the combination of Elmasri and Franklin do not teach or suggest all of the elements of applicants’ claim 34. Therefore, claim 49 which depends directly from claim 34, is patentable for the same reasons, as well as because of the combination of features in those claims with the features set forth claim 34.

VIII. CONCLUSION:

For the reasons set forth above, it is respectfully submitted that all claims in this application clearly define over the prior art. Therefore, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

Applicants reserve the right to request an oral hearing upon receipt of the Examiner's Answer.

Check No. 27331 in the amount of \$500 (large entity) to cover the fee for filing an Appeal Brief is enclosed.

If this Appeal Brief is filed after a shortened statutory time period has elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. §1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. §1.135. The fee under 37 C.F.R. §1.17 should be charged to our Deposit Account No. 15-0700.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on September 6, 2007:

Max Moskowitz

Name of patentee, assignee or
Registered Representative



Signature

September 6, 2007

Date of Signature

MM:JJF:ck

Respectfully submitted,



Max Moskowitz

Registration No.: 30,576

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700

CLAIMS APPENDIX

Claims 1-33 (canceled).

34. A substantially automatic system for correlating metrics associated with a plurality of software products installed on a computer with related software agreement data, the system comprising:

a first computerized software facility operable to interface with a respective software product API of at least one of the plurality of software products in order to obtain the related software agreement data;

a second computerized software facility operable to interface with the respective software product API of the at least one software product in order to obtain software product data;

a software facility API provided by at least one of the first computerized software facility and the second computerized software facility to enable the at least one software product interfaces to supply the related software agreement data or the software product data;

a third computerized software facility operable to correlate substantially automatically the software product data and the software agreement data with one another; and

a fourth computerized software facility operable to output results of said correlation, wherein the system is operable to display and report the results from the fourth computerized software facility, and wherein the system is not operable to affect operation of any software product identified by data correlated by the third computerized software facility.

35. The system of claim 34, in which the computer is a mainframe computer.

36. The system of claim 34, in which the computer is a network of computers.

37. The system of claim 34, in which the software product data is inventory data.

38. The system of claim 34, in which the software product data is usage data.

39. The system of claim 34, in which the software product data is a combination of inventory and usage data.

40. The system of claim 34, in which the agreement data contains a plurality of data fields.

41. The system of claim 40, in which the data fields are selected from a group including:

time and date of transaction; name, address, phone number, e-mail address of vendor; description of asset; manufacturer, model, year, options; warranties, contract terms and conditions; contract information, fee structure; number of concurrent users; renewal dates; MIPS authorization; authorized CPUs; product name; and discounts.

42. The system of claim 34, in which the first software facility comprises a data acquisition system including a plurality of software acquisition tools.

43. The system of claim 42, in which the software acquisition tools include an importing tool for importing at least a portion of the software product data.

Claims 44-45 (canceled).

46. The system of claim 34, in which the third software facility comprises a reconciliation and association facility which includes a plurality of software tools.

47. The system of claim 46, in which the reconciliation and association tools include a tool for resolving inconsistencies and mismatches in product names between the software product data and the software agreement data.

48. The system of claim 34, in which the third software facility is effective for correlating at least 25% of the data contained in one of the software product data and the software agreement product data.

49. The system of claim 34, wherein at least one of the first computerized software facility and the second computerized software facility interface with the at least one software product on a periodic basis.

50. The system of claim 34, wherein at least one of the first computerized software facility and the second computerized software facility interface with the at least one software product on a continuous basis.

51. The system of claim 34, wherein at least one of the first computerized software facility and the second computerized software facility interface with the at least one software product in response to alterations in an inventory of the software products.

Claims 52-57 (canceled).



None.

EVIDENCE APPENDIX



None.

RELATED PROCEEDINGS APPENDIX